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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
958,062	11/09/78	Zola P. Horovitz, et al	HA160A

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EXAMINER	
Seifert	
ART UNIT	PAPER NUMBER
125	9
DATE MAILED:	

MAILED

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

AUG 21 1979

GROUP 120

☐ This application has been examined. ☒ Responsive to communication filed on 6-11-79 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), - days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☐ Notice of References Cited, Form PTO-892.
- ☐ Notice of Informal Patent Drawing, PTO-948.
- ☐ Notice of Informal Patent Application, Form PTO-152.
- ☐

Part II SUMMARY OF ACTION

- ☒ Claims 1-3-25 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
- ☒ Claims 2 has been cancelled.
- ☐ Claims _____ are allowed.
- ☒ Claims 1-3-25 are rejected.
- ☒ Claims Specification is objected to.
- ☐ Claims _____ are subject to restriction or election requirement.
- ☐ The formal drawings filed on _____ are acceptable.
- ☐ The drawing correction request filed on _____ has been ☐ approved. ☐ disapproved.
- ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has
☐ been received. ☐ not been received. ☐ been filed in parent application, serial no. _____,
filed on _____.
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

The specification is objected to under 35 USC 132 as containing new matter. The newly added ratio of "40:1" on page 5 finds no antecedent support in the specification as originally filed. The discloses¹ ranges of ingredients are noted, however, they do not allow for the new ratio.

Claims 13, and 15-20 are rejected under 35 USC 132 as adding new matter to the disclosure. The ranges "5 to 600 mg." and "2.5 to 300 mg." fail to find antecedent support in the specification as originally filed. While the various end points claimed are found in the specification it is apparent from the original disclosure that they refer to two distinct formulations with differing amounts. The joinder of the two distinct ranges is deemed improper.

Claims 1 and 3-25 are rejected under 35 USC 103 as being obvious over Ondetti et al in view of Johnson et al for reasons of record. Applicants' arguments are noted, however, the prima facie rejection of record stands as originally made. The functional relationship between the instant compounds and SQ 20, 881 is deemed sufficient to establish equivilence between the two compounds. Applicants comments concerning the mode of administration are not well taken since it has not been shown that SQ 20,881 is inactive when taken orally. Regardless of the mode of administration, the two compounds have been shown to be functionally equivalent with regard to manner and means of activity.

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Art Unit 125

Applicants comments concerning the difference between enhanced activity and more than additive effect are not understood since there is no data present in the specification which shows synergistic activity with the instant compositions. Finally, it is deemed to be within the skill of the artisan to determine which diuretics would be active in combination with proline derivatives.

No claims are allowed.


This action is made FINAL.

HSS
H. Seifert/tmw

A/C 703

557-2575

8/8/79


ALBERT T. MEYERS
SUPERVISORY PRIMARY EXAMINER
GROUP ART UNIT 125